

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUL 16 2003

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte Paul Adams,  
Floyd Fairbanks and Anthony Sgroi JR.

Application No. 09/817,278

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on June 16, 2003. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed an Appeal Brief on January 27, 2003 (Paper No. 21). On page 3, section (10) of the Examiner's Answer mailed

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on March 25, 2003 (Paper No. 22), the examiner states "claims 1-8, 17-18 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Liang . . . This rejection is set forth in prior Office action, Paper No. 5 and further as amended in Paper No. 15." Additionally, the examiner states id. "[c]laims 68-77 are rejected under 35 U.S.C. 102(a and/or e) as being anticipated by Sung . . . as set forth in prior Office action, Paper No. 10 and further in Paper No. 15." According to the Manual of Patent Examining Procedure (MPEP) § 1208(A) (8th ed., Rev. 1 Feb. 2003):

Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a **single prior action** may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.

Furthermore, MPEP § 706.07 states:

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

A review of the application reveals that the examiner refers to more than one single Office action when stating the grounds of

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rejection, namely, references three Office actions. Therefore, the Examiner's Answer does not comply with the requirements set forth in MPEP §§ 706.07 and 1208(A).

On May 27, 2003, appellants timely filed a Reply Brief and a Request for Oral Hearing (Paper No. 23) as one paper in response to the Examiner's Answer mailed on March 25, 2003 (Paper No. 22). However, it appears that the Reply Brief has not been made of record to the application and no indication is found within the file or otherwise that the examiner has acknowledged/considered the Reply Brief. Section 1208.03 of the Manual of Patent Examining Procedure (8th ed., rev. February 2003) states:

Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, Unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose. [37 CFR 1.193 (b)(1)].

Lastly, on page 5 of the combined Reply Brief and Request for Oral Hearing, appellants included a section requesting an oral hearing in connection with the appeal, and note that a fee in the amount of \$280 is authorized for payment of same.

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Effective December 1, 1997, 37 CFR § 1.194(b) was amended to provide that a request for an oral hearing must be filed in a separate paper.<sup>1</sup>

Since appellants' request for oral hearing was incorporated within the Reply Brief itself due its continuing page numbering as page no. 5 of paper no. 23, it is not filed in a separate paper as required by 37 CFR § 1.194(b). Therefore, appellants', request for an oral hearing cannot be granted. Further, the \$280 fee for the oral hearing which was submitted with the Reply Brief, is refundable under 37 CFR § 1.26 since it was paid by mistake or in excess of that required.

If appellants desire the \$280 fee to be refunded, a request for refund should be filed as soon as possible.

If appellants still desire an oral hearing, a petition under 37 CFR § 1.183 must be filed within two weeks of the mail date of this notice. Such a petition must include (1) a request to suspend the separate paper requirement of 37 CFR § 1.194(b), (2) a showing of facts to establish that an extraordinary situation

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<sup>1</sup> 37 CFR § 1.194(b) provides in pertinent part: If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer.

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exists and that justice requires the separate paper requirement of 37 CFR § 1.194(b) be suspended or waived, and (3) be accompanied by the petition fee set forth in 37 CFR 1.17. This time for filing a petition under 37 CFR § 1.183 is not extendable under 37 CFR 1.136(a). The failure to timely file a petition under 37 CFR 1.183 will result in the appeal being decided without an oral hearing (i.e., on brief).<sup>2</sup>

It is also noted upon review of this application that in the submission of prior art filed prior to any Office action on May 31, 2001 (paper no. 5), that the last 2 of the 24 references listed on appellants' form 1449 were not initialed or otherwise noted by the examiner as being considered/non-considered.

Section 609(C)(2) of the Manual of Patent Examining Procedure (8th ed., rev. 1, February 2003) states in part:

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 . . . Those citations not considered by the examiner will have a line drawn through the citation and any citations considered will have the examiner's initials adjacent thereto . . .

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<sup>2</sup> If appellants decide not to file a petition under 37 CFR § 1.183, the Board of Patent Appeals and Interferences would appreciate a written notice thereof so that a decision on the appeal can be expedited.

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. . . If a statement fails to comply with requirements as discussed in this section for an item of information, a line should be drawn through the citation to show that it has not been considered. The other items of information listed that do comply with the rules and this section will be considered by the examiner and will be appropriately initialed [emphasis added].

Accordingly, it is

ORDERED that the application is returned to the examiner  
for

- (1) the examiner to place the Examiner's Answer in compliance with the requirements set forth in MPEP §§ 706.07 and 1208(A),
- (2) entry of the Reply Brief in the application record and a proper response to the Reply Brief in conformance with 37 CFR § 1.193(b)(1),
- (3) correction of the issue of non-compliance by appellant regarding the Request for Oral Hearing,
- (4) acknowledgment of the 2 unacknowledged prior art references listed on appellants' form PTO 1449 filed on May 31, 2001 (paper no. 5), and
- (5) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

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